

REMARKS

This Amendment is submitted in response to the Office Action mailed on February 23, 2004. The Office Action rejects Claims 1-4, 7-10, 12, 15-17, 21-23, 26-29 and 32-35 under 35 U.S.C. §102(b) and Claims 5, 6, 11, 13, 14, 18-20, 24, 25, 30, 31, 36 and 37 under 35 U.S.C. §103(a). Claims 1, 10, 12 and 33 have been amended. Support for the amendments to Claims 1 and 21 can be found in the Specification, for example at page 8, line 30 through page 9, line 7. Claims 13 and 21-27 have been cancelled without prejudice or disclaimer. Claims 38-49 have been newly added and are supported in the Specification, for example at page 3. Therefore, no new subject matter has been added by this Amendment.

The Patent Office objects to Claims 10 and 33 because of informalities. Claims 10 and 33 have been amended in accordance with changes recommended by the Patent Office. Accordingly, Applicants respectfully submit that such objections have been overcome.

The Patent Office rejects Claims 10 and 33 under 35 U.S.C. §112, ¶2 as being indefinite. Claims 10 and 33 have been amended to particularly point out and distinctly claim the subject matter which Applicants regard as the invention by eliminating the species of some of the claimed genera. Accordingly, Applicants respectfully submit that such rejections have been overcome.

The Patent Office rejects Claims 1-4, 7-10, 12, 15-17, 28-29 and 32-35 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,380,530 to Hill ("*Hill*").

Claims 1, 12 and 28 have been amended to provide a chewing gum including a gum center which includes a metal salt. *Hill* fails to disclose a chewing gum comprising a gum center which includes a metal salt that is designed to provide breath freshening characteristics to a consumer of the chewing gum. Claims 12 and 28 include a gum center which includes a metal salt. Even if the chewing gum composition in *Hill* includes a zinc compound, the zinc compound is only included in the emulsion coating and not the gum center. Therefore, *Hill* fails to disclose a gum center including a metal salt as required by Claims 1, 12 and 28. Accordingly, Applicants respectfully submit these rejections are improper and should be withdrawn.

Hill fails to disclose a method of treating halitosis. Claims 34 and 35 are directed to methods of treating halitosis. Claim 34 includes chewing a chewing gum comprising a gum

center which includes a water-soluble portion, a water-insoluble portion, and a coating that at least substantially surrounds the gum center. The coating includes a therapeutically effective amount of a metal salt to treat halitosis. Claim 35 includes chewing a chewing gum comprising a therapeutically effective amount of a metal salt to treat halitosis, a gum center including a water-soluble portion and a water-insoluble portion, and a coating surrounding the gum center. The coating includes a cooling agent. *Hill* discloses using its chewing gum composition for cleaning and tartar control, antimicrobial and antibiotic effects, dry mouth, oral discomfort, and further for treating caries, gingivitis, hypersensitivity, plaque buildup and *Candida* sp. infections. See *Hill*, col. 4, lines 44-46 and Table II. *Hill*, however, fails to disclose a method of treating halitosis. Even if *Hill* discloses the composition set forth in Claims 34 and 35, the discovery of a new use for this composition, i.e. treating halitosis, based on unknown properties of the composition, can be patentable to the discoverer as a process of using. *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). *Hill* fails to disclose a method of treating halitosis; therefore, the new method of using the composition of the claimed invention is novel and patentable. For at least these reasons, Applicants respectfully submit that these rejections should be withdrawn.

The Patent Office rejects Claims 5, 6, 11, 13, 14, 18-20, 30, 31, 36 and 37 under 35 U.S.C. §103(a) as being unpatentable over *Hill* and in view of U.S. Patent No. 6,030,605 to D'Amelia et al. ("*D'Amelia*").

The Patent Office impliedly admits that *Hill* fails to disclose or suggest a composition which includes a copper salt, and that *Hill* fails to disclose or suggest the presence of a metal salt in the gum center as required by the claimed invention. See Office Action, page 3. Therefore, the Patent Office must rely on *D'Amelia* to demonstrate that it would have been obvious to include zinc or copper salts in the gum center because "it is old to formulate a chewing gum having hygiene benefits, e.g. breath freshening benefits". Applicants respectfully submit, however, that there is no suggestion, teaching or motivation to combine *Hill* with *D'Amelia*, and that *Hill* teaches away from a combination with *D'Amelia*.

To support its combination and/or modification of the cited art to arrive at the claimed invention, it is respectfully submitted that the Patent Office has applied hindsight reconstruction by selectively piecing together teachings of *Hill* with the teachings of *D'Amelia* in an attempt to

re-create what the claimed invention discloses. Without the requisite motivation to combine these teachings, this is clearly improper as being "hindsight reconstructive".

D'Amelia relates to a breath freshening composition that does not include a coating. *D'Amelia* is in complete contrast to the teaching of *Hill* which is primarily directed to disrupting plaque and controlling gingivitis using emulsion coatings containing a zinc compound. In contrast to *D'Amelia*, *Hill* fails to even mention freshening breath with its composition. Furthermore, in contrast to *Hill*, *D'Amelia* fails to disclose or even suggest a composition which includes a coating, a critical component of the chewing gum in *Hill*. In fact, it is the coating of *Hill* that includes the metal salt.

Moreover, *Hill* teaches away from the combination with *D'Amelia*. *Hill* teaches that the release of active ingredients from the gum base is a major problem. See *Hill*, col. 8, lines 63-65. In its disclosure, *Hill* teaches that having a therapeutic agent in the coating allows release of the substance from the gum into the oral cavity during chewing at an effective predetermined rate and in an effective predetermined amount. See *Hill*, col. 15, lines 15-19. Thus, in *Hill* the active ingredient is not included in the gum center. In fact, *Hill* teaches not to include the active ingredient in the gum center. This teaching in *Hill* effectively constitutes a teaching away from its combination with the teachings of *D'Amelia* which require the metal salt to be included in a non-coated gum base of a chewing gum product. Furthermore, why would one coat *D'Amelia*? Why would one put the active agent in the center of *Hill*? There is absolutely no motivation in the art itself for these modifications. The test is not whether the prior art could be modified or combined to achieve the claimed invention. The question is: does the art suggest the modification. Therefore, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated by either *D'Amelia* or *Hill* to combine or modify these references to achieve the claimed invention.

Accordingly, Applicants respectfully request that the rejections be withdrawn and the above-identified patent application be passed to allowance.

Newly added Claim 40 is directed to a product which includes a gum center including a water-soluble portion and a water-insoluble portion and a coating including a copper salt. As discussed above, *Hill* alone, or in combination with *D'Amelia*, fails to disclose a chewing gum

product having a coating which includes a copper salt. Therefore, Applicants respectfully submit that newly added Claim 40 and Claims 41-49 which depend therefrom are also in condition for allowance.

For the foregoing reasons, Applicants respectfully request reconsideration of their patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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